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10/508,959	08/16/2005	Chaim Gilon	28557	7550
7590		10/16/2007		
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			DESAI, ANAND U	
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			10/16/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/508,959

Applicant(s)

GILON ET AL.

Examiner

Anand U. Desai, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-131 is/are pending in the application.
- 4a) Of the above claim(s) 1-68, 74, 79-83 and 87-131 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 69-73, 75-78 and 84-86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 20061030;20061213.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of group VI, drawn to a method of delivering a macromolecule of interest into a cell, the method comprising contacting the cell with the conjugate comprising a histone moiety covalently linked to a macromolecule of interest, said histone moiety being transportable through cell membranes and importable into cell nuclei in the reply filed on August 6, 2007 is acknowledged. Acknowledgment of the species identified as the conjugate H2A-BSA is made. Claim 74 is drawn to a mixture of at least two histone proteins and does not read on the elected conjugate of H2A-BSA. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-68, 74, 79-83, and 87-131 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 6, 2007.

3. With no prior art being found for the elected species, H2A-BSA, the examiner has extended the search to a second species that is H2A-beta galactosidase.

4. Claims 69-73, 75-77, 78, and 84-86 are currently under examination.

***Priority***

5. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(e). The priority date is April 8, 2002.

***Information Disclosure Statement***

6. The information disclosure statements (IDSs) submitted on October 30, 2006, and December 13, 2006 are being considered by the examiner. The full text of reference 31 for the IDS submitted October 30, 2006 has been provided, and the word, abstract has been crossed out of the 1449 form.

***Claim Objections***

7. Claim 69 is objected to because of the following informalities:
8. Claim 69 describes a conjugate described in non-elected withdrawn claim 1. Suggest identifying the conjugate in claim 69.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claim 73 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described

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in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 73 is rejected because the description of any derivative of any histone protein is not described.

The MPEP states that the purpose of the written description requirement is to ensure that the inventor had possession, at the time the invention was made, of the specific subject matter claimed. The courts have stated:

"To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that 'the inventor invented the claimed invention.'" *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); *In re Gostelli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) ("[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966." *Regents of the University of California v. Eli Lilly & Co.*, 43 USPQ2d 1398.

Further, for a broad generic claim, the specification must provide adequate written description to identify the genus of the claim. In *Regents of the University of California v. Eli Lilly & Co.* the court stated:

"A written description of an invention involving a chemical genus, like a description of a chemical species, 'requires a precise definition, such as by structure, formula, [or] chemical name,' of the claimed subject matter sufficient to distinguish it from other materials." *Fiers*, 984 F.2d at 1171, 25 USPQ2d 1601; *In re Smythe*, 480 F.2d 1376, 1383, 178 USPQ 279, 284985 (CCPA 1973) ("In other cases, particularly but not necessarily, chemical cases, where there is unpredictability in performance of certain species or subcombinations other than those specifically enumerated, one skilled in the art may be found not to have been placed in possession of a genus ...") *Regents of the University of California v. Eli Lilly & Co.*, 43 USPQ2d 1398.

MPEP § 2163 further states that if a biomolecule is described only by a functional characteristic, without any disclosed correlation between function and structure of the sequence, it is "not sufficient characteristic for written description purposes, even when accompanied by a method of obtaining the claimed sequence." MPEP § 2163 does state that for a generic claim the genus can be adequately described if the disclosure presents a sufficient number of representative species that encompass the genus. If the genus has a substantial variance, the disclosure must describe a sufficient variety of species to reflect the variation within that genus. See MPEP § 2163. Although the MPEP does not define what constitute a sufficient number of representative species, the courts have indicated what do not constitute a representative number of species to adequately describe a broad generic. In *Gostelli*, the courts determined that the disclosure of two chemical compounds within a subgenus did not describe that subgenus. *In re Gostelli*, 872, F.2d at 1012, 10 USPQ2d at 1618.

In the instant case, the claims are drawn to a method of delivering any macromolecule of interest into a cell, wherein the conjugate comprises any histone moiety covalently linked to any macromolecule of interest.

As stated *supra*, the MPEP states that written description for a genus can be achieved by a representative number of species within a broad genus. Claim 73 is a broadly generic to all possible derivatives encompassed by the claims. The possible variations are enormous to any class of modifications. Since the MPEP states that if a biomolecule is described only by a functional characteristic, without any disclosed correlation between function and structure, it is "not sufficient characteristic for written description purposes, even when accompanied by a method of obtaining the claimed sequence." MPEP § 2163. Here, though the claims may recite

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some functional characteristics, the claims lack written description because there is no disclosure of a correlation between function and structure of what type of structural derivative will confer a membrane transport function beyond those disclosed in the examples in the specification.

Moreover, the specification lacks sufficient variety of species to reflect this variance in the genus since the specification does not provide sufficient examples of derivatives of histone moieties.

While having written description of histone H2A amino acid sequence comprising the nuclear localization signal identified in the specification tables and/or examples, the specification is devoid of a sufficient variety of derivatives that qualify for the functional characteristics claimed.

The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder*, 736, F.2d 1516, 1521, 222 USPQ 369, 372-73 (Fed. Cir. 1984) (affirming rejection because the specification does "little more than outlin[e] goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate.") Accordingly, it is deemed that the specification fails to provide adequate written description for the genus of the claims and does not reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the entire scope of the claimed invention.

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 69, 70, 73, 75, 77, and 78 are rejected under 35 U.S.C. 102(b) as being anticipated by Baake et al. (October 30, 2006 IDS document 31).

Baake et al. disclose the conjugation of histone H2A with beta-galactosidase. The conjugate was expressed in HeLa cells and membrane translocation was detected by fluorescence. The H2A has a nuclear localization peptide sequence for transport of the fusion construct. The expression of the fusion protein was monitored by indirect immunofluorescence (see figures 2 and 3, for H2A conjugates). Nuclear expression requires transport across the nuclear membrane.

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.



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15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 69-73, 75-78, and 84-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baake et al. (October 30, 2006 IDS document 31) in view of Guo et al. (US 2003/0229202 A1).

Baake et al. is discussed above in the 102(b) rejection. Baake et al. does not explicitly disclose a method of delivering a therapeutic or non-marker macromolecule with a H2A membrane translocating peptide. Baake et al. does not disclose the use of a spacer.

Guo et al. disclose the use of a fusion protein for delivery of a compound including a peptide and protein (see claims 1, and 10). The method of delivery is by contacting the cell with the fusion protein (see claim 12). The fusion protein can comprise a linker including a polypeptide linker (see claim 20). The fusion protein can comprise a nuclear localization sequence (see claim 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute components, such as nuclear localization peptide sequences, with other known nuclear localization peptide sequences to transport macromolecules of interest across

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membranes, since the substitution would have resulted in predictable membrane transport for the fusion construct.

### ***Conclusion***

17. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anand U. Desai, Ph.D. whose telephone number is (571) 272-0947. The examiner can normally be reached on Monday - Friday 9:00 a.m. - 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Kathleen Kerr Bragdon can be reached on (517) 272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

October 14, 2007

AD  
/Anand Desai/  
Art Unit 1656  
Patent Examiner